

Beiersdorf 753-HCL
6713-hf 200/271**REMARKS****Summary of Amendments Made**

Claims 1-13 have been cancelled. Claims 14-18 have been amended to account for changing claim dependency. Claims 19-31 have been added. Claims 19-31 are now pending and claims 14-18 are presumed to be withdrawn.

Since process claims 14-18 are linked to product claims 19-23, if the product claims are held allowable either after consideration of this response or upon reversal of the rejection by the BPAI, it is requested that claim 14-18 be rejoined (see MPEP 821.04). In order to maintain compliance with MPEP 821.04 ("In view of the rejoinder procedure, and in order to expedite prosecution, applicants are encouraged to present such process claims, preferably as dependent claims, in the application at an early stage of prosecution."), claims 14-18 remain pending though withdrawn from consideration.

Comment on Final Rejections

As the claims are now directed toward oil-in-water or water-in-oil preparations, it is believed that the prior art rejections are now rendered moot.

As the negative limitation language limitation is still present in newly presented claims 19-31, it is presumed that the examiner could repeat the final rejection under 35 U.S.C. 112, first paragraph, i.e. claims 19-31 would be rejected for new matter/lack of written description for the concept of the absence of vitamin B12.

However, after excluding the background and conclusion, the only statement in support of this rejection is: "However, applicant's support is not persuasive because the subject matter (i.e. absence of vitamin B12) **that was not possessed** by the inventor(s) at the time of the application was filed, and thus, it cannot be excluded." This statement is objected to on two grounds.

First, it is unclear how the concept of the absence of vitamin B12 could be considered not to be possessed at the time the application was filed as the examples which the applicants' representative pointed to as support for this limitation were part of the specification at the time of filing.

Second, the examiner's support for the new matter rejection appears to be based on a conclusionary statement; there is no factual support or evidence in support of this statement to countervail the applicant's evidence of support. Given that there is no requirement for *ipse dixit* or *in haec verba* support for a negative limitation and that a rejection over new matter requires that a new concept be introduced (which in this case it has not because of the originally filed examples), such a conclusionary statement alone does not support a holding of new matter/lack of written description. see summaries of cases below:

Ex parte Williams, 39 USPQ 125 (POBA 1938) - at page 126 - "**Negative expression** in chemical claims ("being otherwise free of") while expressed in terms not found in original disclosure **is not objectionable as eliminating from scope certain materials which may possibly have been included in original disclosure**; limitation has narrowing effect rather than broadening one."

In re Wright, 9 USPQ2d 1649 (Fed. Cir. 1989) - at page 1651 - "Also pointed out in *Smith* and admitted by the board, **"the claimed subject matter need not be described in haec verba in the specification in order for that specification to satisfy the description requirement.** The fact, therefore, that the exact words here in question, "not permanently

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fixed", are not in the specification is not important.

Ex parte Parks, 30 USPQ2d 1234 (Bd. App. 1993) - at page 1236 "We are not unmindful of the decision in *Ex parte Grasselli*, 231 USPQ 393... Under the particular facts in that case, it was held that the negative limitation introduced new concepts in violation of the description requirement of the first paragraph of 35 U.S.C. 112, citing *In re Anderson*, supra. In the situation before us, **it cannot be said that the originally-filed disclosure would not have conveyed to one having ordinary skill in the art that appellants had possession of the concept** of conducting the decomposition step generating nitric acid in the absence of a catalyst."

Therefore, use of negative limitations cannot automatically be used to reject the claims unless evidence is presented as to why the examiner believes the subject matter was not possessed by the applicants.

Closing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Preliminary Amendment (6 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 21 July 2003

By: 

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